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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/945,456      | 08/30/2001  | Michael D. Myers     | 12606-1             | 3931             |

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[REDACTED] EXAMINER

HONG, STEPHEN S

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2176

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/945,456

Applicant(s)

Myers et al.

Examiner

Stephen Hong

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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Aug 30, 2001

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 5-9 is/are pending in the applica

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from considera

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 5-9 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirem

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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### **Part III DETAILED ACTION**

1. This action is responsive to communications: application, filed on August 30, 2001.
2. Claims 5-9 are pending in the case. Claim 5 is an independent claim.

#### *Specification*

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### *Claim Rejections - 35 USC § 112*

4. Claims 6-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are dependent on claims that are either non-existent or improper.

#### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 5-9 are rejected under 35 USC 102(a) as being anticipated by Legal Anywhere Collaborator Version 3.0, Legal Anywhere, LLC, 1997, the product described in pages 1-4 of

<http://web.archive.org/web/19981202150347/www.legalanywhere.com/TLI.htm>.

The claims are rejected based on the product called Legal Anywhere Collaborator, which is a file management and collaboration tool for attorney practitioners (see page 1, under "Product Overview" section). The Legal Anywhere Collaborator allows the "coordinate and manage workflow between attorneys and their clients, staff, co counsel, and virtually any party involved in the process of delivering legal services. (see page 1, first paragraph)"

As per independent claim 5, Legal Anywhere Collaborator teaches the following claimed features of a method for processing data request from clients of particular practitioners on a distributed computer network:

- maintaining a main document database (page 3, "either ...on site at the law firm's... or ..on our premises");
- registering the practitioners (see page 3, "Who would use this product?", different attorneys are set up to use the system);

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- processing document selections of the practitioners to identify respective home document sets of the practitioners (on page 4, for example, "...can access document that a colleague could make available on their intranetntron.." teaches only a necessary set of documents are given access to per practitioner.);
- identifying requesting users as clients of corresponding practitioners (on page 2, second paragraph, "allows for attorneys and ...clients ...to exchange legal documents", teaches recognition of the client);
- processing client requests for permitting access by particular clients to the home document sets of corresponding practitioners and transmitting requesting pages of the home document sets to the particular clients (page 2, in the second paragraph, since the clients can only access documents relating to their own legal matters.).

As per dependent claims 6 and 7, Legal Anywhere Collaborator teaches maintaining a practitioners database, and including practitioner-specific and client-specific portions of the database in pages being transmitted to the particular client (page 4, "provides access control so that an outside attorney can access document" shows practitioner specific page access; and page 2, in the second paragraph, show client specific ).

As per dependent claims 8 and 9, Legal Anywhere Collaborator teaches maintaining client data and tracking client access to the home document sets (page 2, in the third paragraph, "Document ...tracking and storage").

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*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,385,652 B1 5/02 Brown et al. 709/227

6,317,777 B1 11/01 Skarbo et al. 709/204

6,289,460 B1 9/01 Hajmiragha 713/200

6,374,274 B1 4/02 Myers et al. 707/523

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

After-final (703) 746-7238

Official (703) 746-7239

Non-Official/Draft (703) 746-7240

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Stephen Hong

Primary Examiner

July 14, 2002